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AMENDMENT TRANSMITTAL FORM

In re application of: Alan Gary Blahey, et al.
U. S. Serial No.: 09/806,873
Filed: April 3, 2001
For: LONG LIFE GAS ENGINE OIL AND
ADDITIVE SYSTEM

) Before the Examiner
) C. D. Toomer
)
) Group Art Unit 1714
) Confirmation Number 6495

COMMISSIONER FOR PATENTS
Washington, D.C. 20231

Sir:

☒ The undersigned hereby certifies having information and a reasonable basis for belief that this correspondence will be deposited as first-class mail with the United States Postal Service in an envelope addressed to the Commissioner for Patents, Washington, D.C. 20231, on 8/21/02.

Transmittal herewith is an amendment in the above-identified application.

Petition for extension of time pursuant to 37 CFR 1.136 and 1.137 is hereby made, if and to the extent, required. The fee for this extension of time is calculated to be \$ _____ to extend the time for filing this response until _____.

The fee for any changes in number of claims has been calculated as shown below.

CLAIMS AS AMENDED						
(1)	(2) Claims Remaining After Amendment	(3)	(4) Highest Number Previously Paid For	(5) Present Extra	(6) Rate	(7)
Total Claims	*	Minus	**		x 18.00	
Indep. Claims	*	Minus	***		x 84.00	
MULTIPLE DEPENDENT CLAIM FEE					\$280.00	
FEE FOR CLAIM CHANGES						

- * If the entry in Column 2 is less than the entry in Column 4, write "0" in Column 5.
** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, write "3" in this space.

The total fee for this Amendment, including claim changes and any extension of time is calculated to be \$ 0.

☒ Charge \$ 0 to Deposit Account No. 05-1330.

☒ The Commissioner is hereby authorized to charge any additional fees under 37 CFR 1.16 and 1.17 which may be required by this paper, or credit any overpayment, to Deposit Account No. 05-1330.
A duplicate copy of this Form is enclosed.

20 August 2002
Date of Signature

Post Office Address: [to which correspondence is to be sent]
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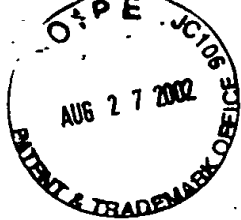
☐ Pursuant to 37 CFR 1.34(a)



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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of Alan Gary Blahey, et al.

U. S. Serial No. 09/806,873

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LONG LIFE GAS ENGINE OIL AND
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Sir:

Amendment

In response to the Office Letter of May 22, 2002 (Paper No. 9) applicants enclose herewith newly amended claims 1 and 6 in both clean form and with markings to show the changes made.

Remarks

Claims 1 and 6 were amended to indicate that the oil does not contain a base stock having a viscosity greater than 20 cSt at 100°C. Support for that amendment can be found at page 5, line 3, for example. Also claims 1 and 6 were amended to indicate that the low ash amount set out at page 2 and the inclusion and amount of antiwear additive as set forth in the first paragraph of page 12.

Additionally claim 1 was amended to indicate that the low amount of VII is sufficient to increase the viscosity of the oil to about 13.2 cSt. Support for that amendment can

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be found at page 14, lines 8 to 10. Claim 1 was further amended by deleting "about" before "9".

Finally, a minor formal amendment was made to claim 1 and exclusion of aminic antioxidants was expressly stated in claim 6.

The Examiner rejected claims 1, 4-6 and 9-14 under 35 USC 102(e) as anticipated by Blahey (US 5,726,133). Applicants respectfully request the Examiner to withdraw that rejection.

Blahey clearly uses high levels of VII's (up to 15 vol%) because he also uses some 1200 SN base stock (see the Examples) which has a viscosity of 20.8 cSt at 100°C. Applicants' claims require the absence of a base stock having a viscosity greater than 20 cSt (and hence 1200 SN) and the presence of only very low levels of VII's. Applicants also exclude amino antioxidants which may be present in Blahey's composition. As amended applicants claims are patentably distinguishable over Blahey.

The Examiner rejected claims 1, 4-6 and 9, 10, 12 and 14 under 35 USC 103(a) based on Inoue (US 5,744,430). Applicants respectfully request the Examiner to withdraw that rejection.

Inoue discloses an oil having a viscosity of 2-8 mm²/s not 9 to 13 cSt. Inoue also discloses adding sufficient VII to increase the viscosity to 5.6 to 12.5 mm²/s. This is a significant, not minor, amount of VII. Amounts of up to 10 wt% are mentioned in Inoue. In contrast, applicants use only a minor amount of VII.

A significant aspect of Inoue that cannot be ignored is the fact that Inoue clearly teaches that it is necessary to have all of the ingredients of his composition present in the specified amounts to achieve a synergistic effect. Therefore, it would not be obvious that a composition and method that uses an oil of a different viscosity, containing a different amount of VI improver with a low ash engine oil detergent would function satisfactorily, even if the amounts were close which in this instance they are not.

In view of the foregoing, applicants request the Examiner to withdraw the rejection based on Inoue.

The Examiner rejected claims 1, 4-6 and 9-10 under 35 USC 103(a) on the basis of Vienna in view of Mortier. Applicants respectfully traverse that rejection.

First applicants' oil has a maximum viscosity of 13 cSt at 100°C which is roughly equivalent to a viscosity of 70 SSU at 100°F. Vienna's mixed base oil has an SSU of 180 to 220 SSU at 100°F (col. 4, lines 36-37) which clearly is outside applicants' range.

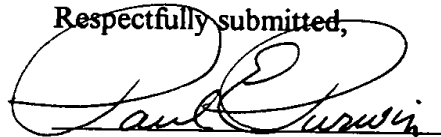
Second, Vienna employs 3 to 5 vol% of tricesyl phosphate, an antiwear agent. This is significantly outside applicants' range.

Third, Vienna's 7 to 12 vol% calcium sulfonate would provide high ash content.

Finally, Vienna states that each of the ingredients is essential. One would likely conclude also that the amounts of those ingredients are also essential. Hence, Vienna is not at all suggestive of applicants' invention.

In view of the foregoing, applicants respectfully request the Examiner to withdraw her rejections and pass the case to issue.

Respectfully submitted,



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☐ Pursuant to 37 CFR 1.34(a)

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